

REMARKS/ARGUMENTS

Reconsideration and allowance of all the claims of record are respectfully requested.

Claims 1, 7-16, 18-24, 28-43, 46, 48-49 and 51-73 are pending in this application.

Information Disclosure Statement (IDS):

An Information Disclosure Statement (IDS) is being concurrently filed herewith along with copies of the cited references. Since portions of each of the cited references is in the English language, no statement of relevance is deemed required. The Examiner is requested to initial the cited references on the Form PTO-1449 and to return a copy of the initialed document to the undersigned as an indication that the cited references have been considered and made of record.

Petition to Expunge:

Applicant filed a Petition to Expunge Under 37 CFR 1.59(b) on August 18, 2005.

Applicant respectfully solicits the USPTO's decision on the Petition.

Rejection Under 35 U.S.C. §103:

Claims 1, 9, 13, 15, 21, 25-32, 35, 39-46, 48, 52-54, 63, 65 and 68 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Kaneko (U.S. '141) in view of Bromley (U.S. '058). Applicant respectfully traverses this rejection.

In order to establish a *prima facie* case of obviousness, all of the claim limitations must be taught or suggested by the prior art. The combination of Kaneko and Bromley fails to teach or suggest all of the claim limitations. For example, the combination fails to teach or suggest "at least a portion of a video game program to be added to the video game program stored by the video game information storage medium is obtained from at least one of the plurality of game cards," as required by independent claim 1.

Similarly, independent claim 63 requires “wherein said video game program to be executed by the processing system of the video game machine includes instructions obtained from at least one of said plurality of game cards to be added to the video game program stored by the video game information storage medium,” and independent claim 65 requires, *inter alia*, “wherein the first game card has encoded thereon a first set of program instructions for execution by said processing system.”

The combination of Kaneko and Bromley fails to teach or suggest the above limitations required by independent claims 1, 63 and 65. Indeed, page 9, lines 8-10 of the Office Action admits that Kaneko and Bromley “do not teach that the recoded (sic - recorded) data (i.e., the barcode) embodies program instructions that are executed by the processing system.” This admission of the Office Action was made in connection with claim 67. However, Applicant submits that it also serves as an admission that the combination of Kaneko and Bromley (alone) fails to teach or suggest all of the claim limitations required by independent claims 1, 63 and 65. Each of these claims requires a game card for embodying program instructions.

Independent claim 13 requires, *inter alia*, “said processing system being operable to execute the video game program based on the video game program stored in said video game information storage medium in such a manner so as to, when the identification code and characteristic data of the previously stored character are supplied by said external information reading circuitry, change a state of the previously stored character by adding the characteristic data supplied by the external reading circuitry to other characteristic data of the previously stored character; and execute the video game program and process the character data of the particular character, when supplied with the identification code and characteristic data of the particular character read from said external information reading circuitry, to animate and display an image of the particular character as a new character.” Independent claim 39 requires, *inter alia*, “a data

reader for reading data from at least one card including data enabling animation and display of a new character during play of a video game provided by execution of the video game program and reading data from at least one other card including data enabling a characteristic of a character which has been previously stored by the program memory to be changed during play of the video game provided by execution of the video game program; processing circuitry for processing data read from the at least one card to animate and display the new character during play of the video game and processing data read from the at least one other card to change an animated and displayed characteristic of the previously stored character.”

Accordingly, the invention required by independent claims 13 and 39 relate to a plurality of cards, wherein one of the cards records data for a previously stored character, and another card records data relating to a new character (a character which has not been previously stored). The data recorded in the first card may be used to change the previously stored character and the data from the second card enables a new character to be generated. By reading data from these various cards, it is possible to change a state of a character(s) that already exists in the game as well as make new a character(s) appear on scenes of a game. Accordingly, the collection of cards allows the game to embrace numerous variations.

Fig. 13 of Kaneko illustrates a game set 5 have a bar code reader 10 for reading card 4. The bar code data inputted to the CPU 51 of the game set 5 is utilized as various parameters (e.g., batting average, runs batted in, earned-run average, etc.) for a preexisting character. There is no teaching or suggestion, however, to implement a new character in the game. Bromley fails to remedy this deficiency of Kaneko.

Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. §103 in view of Kaneko and Bromley be withdrawn.

Claims 8, 10, 14, 34, 36, 51, 56, 57, 64, 66, 69 and 72 were rejected under 35 U.S.C.

§103 as allegedly being unpatentable over Kaneko and Bromley in view of Yokoyama.

Applicant respectfully traverses this rejection. Independent claim 51 requires, *inter alia*, “said processing system being operable to process video graphics image data embodied in said two-dimensional array of dots from said one of the game cards and said another one of the game cards to generate and display the new character and change the another character for video game play.” Independent claim 57 requires, *inter alia*, “processes the characteristic data to apply a change to said video image of an animated and displayed associated character as a result of processing the characteristic data of said one of the game cards and the video game program stored in said game information storage medium and to add the special character as a new character as a result of processing the characteristic data of another one of the game cards and the video game program stored in said game storage medium.” For reasons similar to that discussed above with respect to claims 13 and 39, the combination of Kaneko and Bromley fails to teach or suggest these limitations of claims 51 and 57. Yokoyama fails to remedy this deficiency of the Kaneko/Bromley combination. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. §103 in view of the three-way combination of Kaneko, Bromley and Yokoyama be withdrawn.

Claims 11, 12, 16, 19-24, 37, 38, 60, 67, 70 and 71¹ were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Kaneko and Bromley and further in view of Eskildsen (U.S. ‘839). Applicant respectfully traverses this rejection.

Independent claim 16 requires, *inter alia*, “the machine readable recording also including additional data including executable instructions to be added to the video game program, the executable instructions being readable by the external information reading circuitry and executable by the processing system of the video game machine.” The three-way combination of

Kaneko, Bromley and Eskildsen fails to teach or suggest the above noted limitation.

Section 7 (pages 8-9) of the Office Action appears to rely on Eskildsen for a teaching of game program instructions being obtained from a game card. Eskildsen discloses a user entering several barcodes in a user defined sequence. However, the barcodes (or series of user selected barcodes) disclosed by Eskildsen represent data for indicating a specific function(s) or action(s) which the apparatus can execute (essentially providing data from the barcodes to update variables). The instructions are contained within the apparatus itself as opposed to being provided from the game cards. For example, col. 5, lines 9-14 of Eskildsen explicitly states “This moreover opens up the possibility of supplementing sold units with quite few new elements and new code sheets with codes for actions, for which the instructions are already contained in the apparatus of the invention, without the customer having to buy a new apparatus in order have supplementary functions as well (emphasis added).” Moreover, Eskildsen’s barcodes do not relate to an image display game program (see claim 44).

Eskildsen fails to remedy the above described deficiencies of the Kaneko/Bromley combination with respect to the claims mention other than independent claim 16 and its dependents. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. §103 in view of Kaneko, Bromley and Eskildsen be withdrawn.

Claims 7, 33, 49 and 55 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Kaneko and Bromley and further in view of Garfield (U.S. ‘332). Applicant respectfully traverses this rejection. Garfield fails to remedy the above described deficiencies of Kaneko and Bromley. Accordingly, Applicant submits that claims 7, 33, 49 and 55 are not “obvious” under 35 U.S.C. §103 over the three-way combination of Kaneko, Bromley and Garfield at least for the reasons discussed above with respect to each of these claims’

¹ Applicant assumes that claim 18 was intended to be included in this rejection.

dependency from its respective base claim.

Claims 61 and 62 were rejected under 35 U.S.C. §103 as allegedly being unpatentable over Kaneko and Bromley and further in view of Yamada (U.S. '651). Independent claim 61 requires, *inter alia*, “wherein at least a portion of a game program, to be added to the game program stored in the information storage medium, is received via the external information reading circuitry as data representing executable instructions stored as machine readable recorded data.” Independent claim 62 requires, *inter alia*, “wherein the printed dots printed on the game card represent executable instructions of a game program to be added to the game program stored in the information storage medium.” Even if the teachings of Kaneko, Bromley and Yamada were combined as proposed by the Office Action, the combination would not have taught or suggested these limitations. Accordingly, Applicant respectfully requests that the rejection of claims 61 and 62 under 35 U.S.C. §103 be withdrawn.

New Claim:

New claim 73 has been added to provide additional protection for the invention. Claim 73 depends from claim 1 and thus Applicant submits that this claim is allowable for at least the reasons discussed above with respect to base independent claim 1.

ISHIHARA et al.
Application No. 09/866,541
March 6, 2006

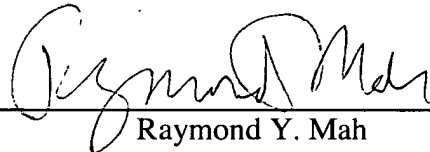
Conclusion:

Applicant believes that this entire application is in condition for allowance and respectfully requests a notice to this effect. If the Examiner has any questions or believes that an interview would further prosecution of this application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:

A handwritten signature in dark ink, appearing to read "Raymond Y. Mah", is written over a horizontal line.

Raymond Y. Mah
Reg. No. 41,426

RYM:sl
901 North Glebe Road, 11th Floor
Arlington, VA 22203
Telephone: (703) 816-4044
Facsimile: (703) 816-4100